72. (Once amended) A method of making a polypeptide of claim 65 comprising the step of:

a) obtaining a cell that expresses [capable of expressing] said polypeptide;

b) growing said cell under conditions suitable to produce said polypeptide; and

c) isolating and purifying said polypeptide produced by said cell.

REMARKS/ARGUMENTS

Claims 76 and 78 were withdrawn from consideration under 37 CFR 1.142(b) as being directed to an invention that is independent or distinct from the elected invention. The Examiner alleged that elected group IV is drawn to an isolated polypeptide and antibody, and that newly added claims 76 and 78 are drawn to a method of binding the antibody, which is classified in separate class 435 and subclass 7.2. Applicants respectfully traverse this withdrawal.

Applicants respectfully respond that claim 76 is drawn to a process of using the antibody of claim 75, and that claim 78 is drawn to a process of using the antibody of claim 77.

In view of the Group practice of combining a method of using an elected composition, Applicants respectfully urge the grouping of claims 76 and 78 with the elected group.

Status of the claims

Claims 46, 47 and 65-78 are pending and currently under examination.

In the Office Action of November 26, 2001, claims 46, 47, 65-75 and 77 were rejected under 35 U.S.C. § 102(b). Applicants respectfully traverse this rejection, as discussed *infra*.

In addition, claims 47 and 71 were rejected under 35 U.S.C. § 112, second paragraph. It is assumed that the Examiner was referring to amended claims 47 and 72. Each of these rejections under 35 U.S.C. § 112 has been obviated by the present amendment and will not be discussed further.

Claims 76 and 78 were withdrawn from consideration under 37 CFR 1.142(b) as being directed to a non-elected invention. Applicants reserve full rights to prosecute non-elected claims 76 and 78 in divisional applications. Applicants respectfully traverse this withdrawal, as discussed *supra*.

Rejections under 35 U.S.C. § 102(b)

Claims 46, 47, 65-75 and 77 were rejected under 35 U.S.C. § 102(b), as being anticipated by Bowcock *et al.* (WO 9812327-A2). According to the Examiner, WO 9812327-A2 provides (i) a composition of a purified or recombinant polypeptide; (ii) an antibody; (iii) a recombinant vector; (iv) host cells; (v) a method for producing proteins or peptides; and (vi) pharmaceutically acceptable carriers that meet the limitations in the Claims 46, 47, 65-75 and 77. Applicants respectfully traverse this rejection.

Applicants respond, first of all, that WO 9812327-A2 does not provide an isolated, purified or recombinant polypeptide that meet the limitation of claim 46.

The Examiner bases the rejection of claim 46 on SEQ ID No. 52 of WO 9812327-A2. Applicants point out that SEQ ID No. 52 of WO 9812327-A2 does not teach the amino acids at positions 1 to 1629 of SEQ ID No 5. Thus, SEQ ID No. 52 of WO 9812327-A2 does not comprise a contiguous span of at least 6 amino acids including at least 1 of the amino acid positions 1 to 1629 of SEQ ID No 5.

The Examiner also bases the rejection of claim 46 on the assertion that Bowcock *et al.* teach a composition of a purified or recombinant polypeptide which comprises at least 6 contiguous amino acids of SEQ ID No 52 wherein at least 1 amino acid position is substituted (see, e.g., page 6, lines 19-22 of WO 9812327-A2). Bowcock *et al.*, however, do not teach any specific substitutions. In particular, no polypeptide which comprises at least 6 contiguous amino acids of SEQ ID No 52 wherein (i) the amino acid at position 64 of SEQ ID No 52 is an asparagine; the amino acid at 225 of SEQ ID No 52 is a valine; the amino acid at position 338 of SEQ ID No 52 is an asparagine; the amino acid at position 378 of SEQ ID No 52 is a glutamic acid; or the amino acid at position 421 of SEQ ID No 52 is an alanine is teached in WO 9812327-A2. As stated in MPEP § 2131:

> To anticipate a claim, the reference must teach every element of the claim. (...) The identical invention must be shown in as complete detail as is contained in the claim.

Thus, as WO 9812327-A2 does not describe (i) the amino acids at positions 1 to 1629 of SEQ ID No 5; and (ii) an asparagine at amino acid position 1694 of SEQ ID No 5, a valine at amino acid position 1854 of SEQ ID No 5, an asparagine at amino acid position 1967 of SEQ ID No 5, a glutamic acid at amino acid position 2017 of SEQ ID No 5, and an alanine at amino acid position 2050 of SEQ ID No 5, claim 46 is not anticipated by WO 9812327-A2. For the same reasons, the polypeptides and compositions comprising an isolated and purified polypeptide of claims 65-71 are also not anticipated by WO 9812327-A2.

In view of all of the above Applicants submit that the polypeptides of the present claims are not anticipated by WO 9812327-A2, and that the methods of producing the polypeptides, antibodies that specifically bind to the polypeptides and methods of binding the antibodies to the polypeptides that are provided in claims 47 and 72-78 are not anticipated by WO 9812327-A2. Accordingly, withdrawal of the rejection under 35 U.S.C. § 102(b) is requested.

Please charge any additional fees, or credit overpayment to Deposit Account No. 50-1181.

Respectfully submitted,

GENSET CORPORATION

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AARON J. SCALIA
Typed or Printed Name of Person Signing Certificate

VERSION WITH MARKINGS TO SHOW CHANGES MADE

47. (Once amended) An isolated or purified antibody composition that selectively binds ~~capable of selectively binding~~ to an epitope-containing fragment of a polypeptide according to claim 46, wherein said epitope comprises:

- at least 1 of the amino acid positions 1 to 1629 of the SEQ ID No 5; or

- an amino acid selected from the group consisting of an asparagine at amino acid position 1694 of SEQ ID No 5, a valine at amino acid position 1854 of SEQ ID No 5, an asparagine at amino acid position 1967 of SEQ ID No 5, a glutamic acid at amino acid position 2017 of SEQ ID No 5, and an alanine at amino acid position 2050 of SEQ ID No 5.

72. (Once amended) A method of making a polypeptide of claim 65 comprising the step of:

a) obtaining a cell that expresses ~~capable of expressing~~ said polypeptide;

b) growing said cell under conditions suitable to produce said polypeptide; and

c) isolating and purifying said polypeptide produced by said cell.